

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

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FEB 23 2007

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

723-1458

FACSIMILE CERTIFICATE

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Signature: _____

Michael J. Shea

Application Number

10/805,243

Filed

March 22, 2004

First Named Inventor

ECK

Art Unit

3714

Examiner

S. Pandya

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 34,725
(Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1.34 _____


Signature

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Typed or printed name

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Requester's telephone number

February 23, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

ECK et al.

Atty. Ref.: 723-1458; Confirmation No. 9063

Appl. No. 10/805,243

TC/A.U. 3714

Filed: March 22, 2004

Examiner: S. Pandya

For: GAME MACHINE HAVING WIRELESS COMMUNICATION CAPABILITY

* * * * *

February 23, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the OG Notice of July 12, 2005, applicants hereby request a pre-appeal brief review of this case for at least the following reasons. This Request accompanies a Notice of Appeal.

Remarks begin on page 2.

02/26/2007 HMARZ11 00000032 10005243

01 FC:1401

500.00 OP

02/26/2007 HMARZ11 00000032 10005243

02 FC:1251

120.00 OP

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 17-29, 46 and 54-67 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-44 of “copending Application No. 09/659738”. (Applicants note that claim 64 was previously canceled without prejudice or disclaimer.) First, the ‘738 application was issued as U.S. Patent No. 6,716,103 on April 6, 2004. Second, as explained in detail in both of Applicants’ prior responses, claims 17-28 correspond to claims 51-62 of the above-mentioned parent ‘738 application which were restricted by the USPTO. Documentation evidencing the restriction was attached to Applicant’s prior responses. The 3/29/2006 Office Action and the 10/23/2006 Office Action provide no response whatsoever to this argument, nor any explanation as to how a double patenting rejection can be properly maintained in view of the restriction requirement in the parent application. The double-patenting rejection of claims 17-28 is improper and must be withdrawn. Like claim 17, claim 29 calls for transmitting messages via a paging system if sufficient message credits are stored in a memory. Consequently, this claim corresponds to the subject matter that was restricted in the parent ‘738 application. The double-patenting rejection of claim 29 is improper and must be withdrawn. With respect to claims 46, 54-63 and 65-67, the office action sets forth no basis whatsoever for a double patenting rejection. A rejection without explanation is entirely improper and must be withdrawn.

Claims 46, 56, 57, 60, 62, 64 and 65 were rejected under 35 U.S.C. Section 103(a) as allegedly being “obvious” over Darling et al. and further in view of Hilgendorf et al. Claim 46 is directed to a hand-held game machine comprising a display, radio frequency communication circuitry for transmitting and receiving messages over a wireless communication network, and a processing system for executing a video game program, wherein the processing system is responsive to a received message for disabling the radio frequency communication circuitry. The office action acknowledges the deficiency of Darling et al. with respect to disabling the radio frequency communication circuitry, but alleges that col. 4, lines 40-63 and col. 6, line 61 to col. 7, line 3 of Hilgendorf et al. “teaches of transmitting a disable signal over a line in response to a fault detection” 10/23/2006 office action, page 4.

Hilgendorf et al. relates to progressive slot machines and the referenced portions of Hilgendorf et al. relate to a disable signal for disabling slot machines 10 when, for example, a fault is detected in communication between a progressive controller 30 and a communication unit 26 or when certain jackpots occur. Hilgendorf et al. does not disclose radio frequency communication circuitry and thus cannot disclose or suggest disabling such circuitry in response to a received message. Moreover, the Darling et al. system is not described as including a progressive controller or as providing jackpots and thus one of ordinary skill would never have even thought of applying the disabling concept disclosed in Hilgendorf et al. to the game machine of Darling et al. Consequently, the proposed combination of Darling et al. and Hilgendorf et al. is deficient at least with respect to this feature of claim 46.

Claims 56, 57, 60, 62, 64 and 65 were also rejected based on the proposed combination of Darling et al. and Hilgendorf et al. These claims all depend from claim 55 which is rejected based on a proposed combination of Darling et al., Wagner et al. and Marrs. Applicants respectfully submit that claims 56, 57, 60, 62, 64 and 65, which depend from a claim (i.e., claim 55) rejected by a proposed combination of Darling et al., Wagner et al. and Marrs, are not properly rejected based on a combination of only Darling et al. with Hilgendorf et al., where Hilgendorf et al. is only referenced in connection with its disclosure of disabling slot machines.

Claims 17-26 and 29 were rejected under 35 U.S.C. Section 103(a) as allegedly being “obvious” over Darling et al. (WO 93/23125) in view of Marrs (U.S. Patent No. 5,376,931). Independent claims 17 and 29 each calls for transmitting messages only if sufficient message credits are stored in a memory. Darling et al. contains no disclosure relevant to this feature. Marrs clearly and unambiguously relates to a message debiting system in which debit units are debited from a debit meter to enable presentation of a stored message. See also Marrs, col. 4, lines 21-23 (“the debit meter 72 then indicates the remaining number of credit units available for subsequently received and stored messages.”) (emphasis added). However, each of claims 17 and 29 relates to transmitting messages only if sufficient message credits are stored in a memory. Nothing in Darling et al. or Marrs discloses or suggests conditioning the transmitting of messages on sufficient message credits as claimed and the combination of these documents would likewise be deficient in this regard.

The office action responds to these arguments by noting that Marrs includes a debit meter 72 “that indicates a number of available credit units for enabling the presentation of the stored message information” and [t]he controller enables access to the stored message with (sic) there is sufficient number of credits available and disables the access with insufficient credits ...” 10/23/2006 Office Action, page 15 (emphasis added). These observations in the office action confirm Applicant’s argument that Marrs does not disclose or suggest conditioning the transmitting of messages on sufficient credits being available as claimed.

Applicants traverse the rejections of claims 18-26 and do not acquiesce in the characterization of the applied references with respect to these claims. In any event, these claims depend from claim 17 and are believed to be allowable because of this dependency and because of the additional patentable features contained therein.

Claims 27 and 28 were rejected under 35 U.S.C. Section 103(a) as allegedly being “obvious” over Darling et al. in view of Marrs, and further in view of Taskett et al. (U.S. Patent No. 6,044,247). Taskett et al. is cited for its purported disclosure of a paging card for replenishing a pager account balance. However, the account balance in Taskett et al. relates to accessing voice messages or phone numbers via a call controller 306 and then making telephone calls. Moreover, in addition to failing to disclose or suggest the subject matter of claims 27 and 28, Taskett et al. does not cure the above-noted deficiencies of Darling et al. and Marrs with respect to claim 17 (from which claims 27 and 28 depend).

Claim 54 was rejected under 35 U.S.C. Section 103(a) as allegedly being “obvious” over Darling et al. in view of Wagner et al. (“Human Factors Design Guide”). Claim 54 depends from claim 46 and neither Darling et al. nor Wagner et al. discloses, among other things, a processing system that is responsive to a received message for disabling radio frequency communication circuitry. Consequently, even if Darling et al. were for some reason provided with a touch-sensitive screen based on Wagner et al. as proposed in the office action, the result would still be deficient with respect to the features of claim 46, from which claim 54 depends.

Claims 55, 58, 59, 61, 63, 66 and 67 were rejected under 35 U.S.C. Section 103(a) as allegedly being “obvious” over Darling et al. in view of Wagner et al. and further in view of Marrs.


Claim 55 calls for a storage device for storing user-defined graphics and symbols for composing messages. Wagner et al. and Marrs provide no disclosure relevant to storing user-defined graphics and symbols for composing messages. The office action nonetheless maintains that this feature is an obvious design-choice because, among other things, "applicant has not disclosed that storing user-defined messages solves any stated problem or is for any particular purpose and it appears that the memory 22 in the game machine 10 of Darling et al. would perform equally well storing both predefined messages and user-defined messages." Nothing in 35 U.S.C Section 103 relieves the USPTO of its responsibility to provide evidence of obviousness because of an alleged failure, for example, to disclose that a particular feature solves a problem or is for a particular purpose. There is simply no documentary evidence of record that establishes the obviousness of modifying Darling et al. to provide this feature.

The office action responds to these arguments by alleging that col. 3, lines 20-43 and col. 3-4, lines 51-23 disclose storing "user defined graphics and symbols". 10/23/2006 Office Action, page 16. However, a simple inspection of these referenced portions of Marrs reveals that no such disclosure is contained therein. Instead, these portions relate to receiving messages, storing the received messages and displaying the stored messages. There is nothing about user defined graphics and symbols for composing messages.

Applicants traverse the rejections of claims 58, 59, 61, 63, 66 and 67 and do not acquiesce in the characterization of the applied references with respect to these claims. In any event, these claims depend from claim 55 and are believed to be allowable because of this dependency and because of the additional patentable features contained therein.

For at least these reasons, Applicants respectfully submit that the rejections of the pending claims are improper and should be withdrawn.

Respectfully submitted,
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